

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: A8400

Richard J. BIES

Appln. No.: 10/523,827

Group Art Unit: 2425

Confirmation No.: 4006

Examiner: Nnenna Ngozi EKPO

Filed: April 15, 2005

For: INTERNET-BASED SUBMISSION OF CABLE NETWORK CONTENT

SUBMISSION OF REPLACEMENT APPEAL BRIEF

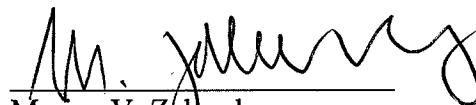
MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to Notice of the Non Compliant Appeal Brief, submitted herewith please find
a Replacement Appeal Brief.

Respectfully submitted,



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WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: June 18, 2009

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REPLACEMENT APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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I. REAL PARTY IN INTEREST

The real party in interest is Richard J. Bies, the inventor of the present application.

II. RELATED APPEALS AND INTERFERENCES

Upon information and belief, there are no other prior or pending appeals, interferences or judicial proceedings known to Appellant's Representative or the Assignee that may be related to, be directly affected by, or have a bearing on the Board's decision in the Appeal.

III. STATUS OF CLAIMS

Claims 1-20 are all the claims pending in the application and are all rejected in the Final Office Action dated September 2, 2008.

Claims 1-20 are on Appeal.

All of the claims pending in the appeal are set forth in their entirety in Appendix A, attached to this Brief on Appeal.

IV. STATUS OF AMENDMENTS

No Amendment subsequent to Final Rejection has been submitted.

A Notice of Appeal was filed February 27, 2009.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

In an exemplary, non-limiting embodiment of the present invention, the users send user searches over a digital broadcast channel of the television network, and the response is made by retrieving advertising information from the data gateway. (Fig. 1). Advertisers make information available but the information is provided to users in response to a user search for information. (Paragraphs 13, 28, 30). The advertisers put advertising information on file (via the internet), and users pull the information by way of a search (via the digital broadcast channel of the television network) *e.g.*, the user may request pizza delivery places in Alexandria, VA. Unlike the conventional techniques, where the advertisers push the advertisement information to the selected users, for example, based on their personal information, an exemplary embodiment is directed to requesting, by the user, the desirable advertising information, *e.g.*, based on a pull technique.

In an exemplary, non-limiting embodiment of the present invention, the advertiser provides content information via internet. Based on this information, the advertising is automatically generated and converted to a format acceptable for the cable network. (Paragraph 24, Fig. 1). Accordingly, the advertising information can easily be updated and modified by the advertiser.

Claim 1 is directed to a television network content delivery system configured to provide advertising information via a digital broadcast channel of a television network. A data gateway 31 stores the advertising information, which is adapted by a cable content generator 26 for transmission over the digital broadcast channel of the television network based on content information received from an advertiser 21 over an internet 24. An advertising information retriever 7 processes a user search received via the digital broadcast channel of the television network and retrieves the advertising information from the data gateway 31 based on the user search. An advertising information provider 6 transmits, based on the user search, advertising information retrieved by the advertising information retriever via the digital broadcast channel of

the television network 5. (*See*, for example, page 3, lines 16-18, page 7, lines 9-26, page 8, lines 2-10, page 9, lines 14-18, FIG. 1).

Claim 2 depends on claim 1. The user search is transmitted by a user via a set-top box 3 or a television 4 to the digital broadcast channel of the television network 5. In the user search, the user designates a category of advertising. Based on the designated category, the advertising information retriever searches advertising information listings stored in the data gateway and selects the advertising listings that match the designated category and other criteria which includes a geographical location of the user. The set-top box or the television is connected to the television network via a cable wire, an antenna receiving a television broadcast frequency, a satellite dish, or other wireless connection. (*See*, for example, page 7, lines 6-21, page 9, lines 4-10, page 16, lines 11-26, page 17, lines 1-3, FIG. 1).

Claim 10 is directed an advertising content interface 20 configured to provide advertising information adapted for transmission over a digital broadcast channel of a television network by a television network headend. An interface unit 25 receives content information from an advertiser 21 via an internet 24. A cable content generator 26 processes the content information received by the advertiser interface and generates advertising information adapted for transmission over the cable network 5. A data gateway 31 stores the advertising information generated by the cable content generator 26 and responds to an information demand from the cable network by providing the advertising information to the cable network headend for transmission over the cable network. (*See*, for example, page 3, lines 16-18, page 7, lines 9-26, page 8, lines 2-10, page 9, lines 14-18, FIG. 1).

Claim 16 is directed to a method of receiving content information and providing advertising information over a cable network. Content information from an advertiser is received via an internet. The content information is processed. Advertising information adapted for transmission over the cable network is generated. The generated advertising information is

stored. An advertising search is received via the digital broadcast channel of the television network. The stored advertising information is retrieved according to the advertising search. The retrieved advertising information is provided via the digital broadcast channel of the television network. (See, for example, page 3, lines 16-18, page 7, lines 9-26, page 8, lines 2-10, page 9, lines 14-18, FIG. 1).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claim 1 and dependent claims 3-7 and 9 are properly rejected under 35 U.S.C. § 102(a) as being anticipated by Stettner (U.S. Patent Application Publication No. 2002/0104090).
2. Whether claim 10 and dependent claims 11-14 are properly rejected under 35 U.S.C. § 102(a) as being anticipated by Stettner (U.S. Patent Application Publication No. 2002/0104090).
3. Whether claim 16 and dependent claim 17-19 are properly rejected under 35 U.S.C. § 102(a) as being anticipated by Stettner (U.S. Patent Application Publication No. 2002/0104090).
4. Whether claims 2 and 20 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Stettner (U.S. Patent Application Publication No. 2002/0104090) in view of Thomas (U.S. Patent Application Publication No. 2008/0196053).
5. Whether claims 8 and 15 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Stettner (U.S. Patent Application Publication No. 2002/0104090) in view of Merriman (U.S. Patent No. 5,948,068).

VII. ARGUMENT

A. Claim 1 and dependent claims 3-7 and 9 are not anticipated by Stettner

To anticipate under § 102, each and every element of the claim must be found in a single prior art reference. Additionally, the elements found in the single prior art reference, must be arranged as they are arranged in the claim. Accordingly, a rejection under 35 U.S.C. § 102 is proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention. MPEP § 2131.

Claim 1 recites among other elements: “an advertising information retriever configured to process a user search received via the digital broadcast channel of the television network, and to retrieve the advertising information from said data gateway based on the user search.”

1. The Cited Prior Art

Stettner describes presenting an interactive advertisement system to a potential customer. (Paragraph 49). An information-available button or icon is present during the viewing of an advertisement to indicate the availability of the supplemental information and/or facilitate a purchase. (Paragraph 50).

Therefore, Stettner is directed to improving the results of advertising by making it easy for the user to respond to the displayed advertisement. For example, Stettner describes how a TV advertisement for pizza, even when viewed by a hungry user wanting pizza, must necessarily be responded to by writing down the telephone number, calling the pizza restaurant, etc. Stettner provides an “information-available” type button to be present during the advertisement, to make the ordering of products easier. (Paragraphs 7, 9). The users can use their TV to activate the button, thereby initiating a transaction (*see* button 404 in Fig. 4).

Specifically, in the example shown in FIG. 4, the indicator 404 is a "Buy" button that invites the viewer to buy airline tickets. The indicator 404 may be an "Info" button that requests the merchant to provide information about the tickets, there may be multiple indicators 404, or one or more indicators may be used for a combination of purposes (e.g., buying, requesting information, turning enhanced content on/off, activating a menu, etc.). (Paragraphs 49, 50).

Stettner further describes correlating a customer to an advertisement, which is being already displayed, when the user clicks the indicator 404. (Paragraph 57). Once the customer is correlated, the merchant 122 is notified by the advertising service at a block 512 to contact the customer. The merchant 122 is notified implicitly by redirection of the customer's browser or set top box 152 to the merchant's 122 web site 124, for example. This redirection may be performed by a server in the distribution center 306 and results in a connection of the merchant 122 to the customer at a block 514. This can be implemented via use of triggers that are embedded with the television transmission having the interactive advertisement 402. When the indicator 404 is clicked, the set top box 152 is redirected to the URL address of the merchant's web site 124, with the URL addresses capable of being obtained from the triggers or from other embedded information that is sent along with the interactive advertisement 402. Once at the web site 124, the customer can communicate with the merchant 122 by filling out an electronic form or by providing other input (such as by clicking hyperlinks) to get the response fulfilled. (Paragraph 58).

2. Examiner's Position

The Examiner alleges that the user pressing the indicator 404 anticipates the user search set forth in claim 1 and in response to this command, advertising information is provided. (*see* pages 2-3 of the Final Office Action).

However, the advertising information in Stettner is presented prior to the user pressing indicator 404, e.g., prior to performing the alleged user search. Accordingly, the advertising information is "pushed" on the user, without the user initiating a request.

Additionally, a user pressing "Buy" indicator does not teach or suggest a user search. As discussed above, the gist of Stettner's invention is to push the advertising information to a user who has not asked for it, e.g., in a conventional manner. The purchase of the advertised item is made easy for the user by providing a button 404, which user can press if a purchase is desired.

Stettner does not teach or suggest providing the advertising information based on the user search as an initial matter. For example, as can be seen in Fig. 5 of Stettner, the user is forced to see an interactive advertisement (step 506). The user has not asked for this advertisement; it is

an advertisement of the type common to broadcast media. This advertisement is presented to the user without user's request as indicated by the "potential" customer recitation in paragraph 49. This type of advertising is presented to any potential customer who happens to watch a program. Pressing the button initiates customer's response to advertising. (Paragraph 51). Such type of advertising is a push-based advertising; while advertising according to Appellant's concepts is a pull-based advertising that is provided in response to user search. This type of advertising is not provided for viewing whatsoever unless the user specifically asks for the specific advertisement, e.g., "based on the user search," as claimed.

In the Advisory Action, the Examiner states that the "pull" advertising is not recited in the claim. While this statement is accurate, the discussion here is to illustrate the differences between the advertising methodology of Stettner and the advertising methodology according to the Appellant's concepts, disclosed in claim 1. Accordingly, Stettner's methodology corresponds to the push-based advertising, while the system recited in claim 1 corresponds to the pull-based advertising.

Additionally, clicking an "Info" button that provides additional information about the product or a "Buy" button to purchase the merchandise, as described in Stettner (Paragraph 50) does not describe a user search because the corresponding merchandise is already selected. (Paragraph 51 of Stettner). That is, Stettner only describes a user command to buy the merchandise being advertised on TV or to request additional information about the merchandise already being advertised. This is not the same as or an equivalent of a user search for advertising information, where, for example, a number of available merchandise meeting criteria may be specified in the user search and searched.

3. *Concluding Remarks with Respect to Claim 1 and its dependent claims*

Accordingly, "an advertising information retriever configured to process a user search received via the digital broadcast channel of the television network, and to retrieve the advertising information from said data gateway based on the user search..." as set forth in claim 1 is not described by Stettner. Stettner lacks a user search and, accordingly, retrieving the advertising information based on the user search. For at least these exemplary reasons, **claim 1**

is patentably distinguishable from Stettner. Dependent **claims 3-7 and 9** patentably distinguish over Stettner at least by virtue of their dependencies.

B. Claim 10 and dependent claims 11-14 are not anticipated by Stettner

Claim 10 recites among other elements: “an interface unit configured to receive content information from an advertiser via an internet; a cable content generator configured to process the content information received by said advertiser interface and to generate advertising information adapted for transmission over the cable network.”

In response to Appellant’s arguments that Stettner is silent with respect to how the advertising contents are created/generated, the Examiner refers to Paragraphs 42-48 of Stettner. (*see* Advisory Action). In the cited portions, however, Stettner describes various distribution channels, *e.g.*, using internet 302 to distribute multimedia content, caches, and a server to guide the user to the merchant’s website. Nowhere in the cited portions does Stettner describe how the advertising content is generated.

Also, in the Advisory Action, the Examiner states that claim 10 does not state “how the advertising content is generated.” As recited in claim 10, however, the content information received by the advertiser interface is processed to generate advertising information adapted for transmission over the cable network. Accordingly, claim 10 calls for processing the content information appropriately for transmission over the cable, *e.g.*, formatting the content information so that it can be transmitted over the cable channel.

Further, Stettner describes the user interacting with the merchant via Internet. However, in the cited portions, there is no disclosure of receiving the content over the Internet and creating the advertising information which can be transmitted over the cable television. Stettner is simply not concerned with *how* the advertisements are generated, formatted, or provided.

Accordingly, Stettner does not teach or suggest an interface unit configured to receive content information from an advertiser via an internet and a cable content generator configured to process the content information and generate advertising information adapted for transmission over the cable network.

Therefore, Appellant respectfully submits that **claim 10** patentably distinguishes over Stettner. Dependent **claims 11-14** patentably distinguish over Stettner at least by virtue of their dependencies.

C. Claim 16 and dependent claims 17-19 are not anticipated by Stettner

Claim 16 recites features similar to those discussed above regarding claims 1 and 10. Accordingly, **claim 16** patentably distinguishes over Stettner at least for the reasons discussed above regarding claims 1 and 10. Dependent **claims 17-19** patentably distinguish over Stettner at least by virtue of their dependencies.

D. Claims 2 and 20 are not unpatentable over Stettner in view of Thomas

Claim 2 recites among other elements: “the user search comprises the user designating a category of advertising, based on the designated category, the advertising information retriever searches advertising information listings stored in the data gateway and selects the advertising listings that match the designated category and other criteria, said other criteria comprises at least a geographical location of the user.”

The Examiner acknowledges that Stettner does not disclose the above-recited features of claim 2. The Examiner, however, alleges that Thomas cures these deficiencies (*see* pages 11-12 of the Final Office Action). Appellant respectfully disagrees.

Thomas is directed to monitoring usage of interactive television program guide. Thomas further describes that real-time ratings information (e.g., real-time ratings of the popularity of certain television programs, video games, or other applications) may be provided to users in real time. (*see* Abstract). In the passage relied on by the Examiner, Thomas describes that the user is provided with an opportunity to select the type of ratings that the user wishes to view and the geographic area for which the ratings should be provided. After the user selected the ratings, they are displayed to the user. (Paragraphs 70-71). Thomas, however, is unrelated to advertising and describes selecting types of ratings. That is, Thomas does not describe or even remotely suggest selecting a category of advertising. Instead, Thomas describes selecting type of ratings.

Furthermore, Thomas is not relevant. Stettner already has an indicator 404 for obtaining additional information about a particular merchandise being advertised on the TV. Since the indicator 404 is directly linked to the specific merchandise in Stettner, there is no reason or motivation to specify a category. The Examiner alleges that the advantage of the proposed combination is to receive desired advertisements. (*see* page 12 of the Final Office Action). In Stettner, however, the user already receives enhanced information directly linked to the desired merchandise, by clicking the displayed button. There is no reason to specify a category when the desired information is already provided with a click of a button. One of ordinary skill in the art would not have looked into Thomas to have Thomas combined or modified with Stettner to specify a category because this is unnecessary and cumbersome.

For at least these additional exemplary reasons, **claim 2** is patentable over Stettner in view of Thomas.

Claim 20 depends on claim 1 and is patentable at least by virtue of its dependency.

E. Claims 8 and 15 are not unpatentable over Stettner in view of Merriman

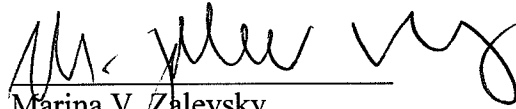
Claim 8 depends on claim 1 and **claim 15** depends on claim 10. Accordingly, claims 8 and 15 are patentable at least by virtue of their dependencies.

CONCLUSION

In view of the foregoing, Appellant respectfully requests the Board withdraw rejections of **claims 1-20**.

The USPTO is directed and authorized to charge the statutory fee (37 C.F.R. §41.37(a) and 1.17(c)) and all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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23373

CUSTOMER NUMBER

Date: June 18, 2009

CLAIMS APPENDIX

CLAIMS 1-20 ON APPEAL:

1. (previously presented): A television network content delivery system configured to provide advertising information via a digital broadcast channel of a television network, said television network content delivery system comprising:

a data gateway configured to store the advertising information, the advertising information being adapted by a cable content generator for transmission over the digital broadcast channel of the television network based on content information received from an advertiser over an internet;

an advertising information retriever configured to process a user search received via the digital broadcast channel of the television network, and to retrieve the advertising information from said data gateway based on the user search; and

an advertising information provider configured to transmit, based on the user search, advertising information retrieved by said advertising information retriever via the digital broadcast channel of the television network.

2. (previously presented): The television network content delivery system of claim 1, wherein:

the user search is transmitted by a user via a set-top box or a television to the digital broadcast channel of the television network,

the user search comprises the user designating a category of advertising,

based on the designated category, the advertising information retriever searches advertising information listings stored in the data gateway and selects the advertising listings that match the designated category and other criteria,

said other criteria comprises at least a geographical location of the user, and

the set-top box or the television is connected to the television network via at least one of a cable wire, an antenna receiving a television broadcast frequency, a satellite dish or other wireless connection.

3. (previously presented): The television network content delivery system of claim 1, wherein the advertising information includes at least one of an advertiser listing, a text message, a survey questionnaire, a picture, an audio clip, and a video clip.

4. (previously presented): The television network content delivery system of claim 1, wherein the television network content delivery system is implemented as at least two data processors comprising a cable headend server and a master server.

5. (previously presented): The television network content delivery system of claim 1, wherein the user search is an advertiser search command.

6. (previously presented): The television network content delivery system of claim 5, wherein the advertiser search command includes at least one of an advertising information geographic selection and an advertising information temporal selection, selecting, respectively, advertising information designated by the advertiser for a designated geographical area and advertising information designated by the advertiser for a designated time period.

7. (previously presented): The television network content delivery system of claim 5, wherein the advertiser search command is for a category of advertising, the category of advertising being one of a field of business endeavor of the advertiser, type of organization of the advertiser, and type of product advertised by the advertiser.

8. (previously presented): The television network content delivery system of claim 1, further comprising a delivery status interface configured to generate a report provided to the

advertiser about delivery of the advertising information over the digital broadcast channel of the television network, the report indicating the number of times the advertising information was viewed.

9. (previously presented): The television network content delivery system of claim 1, wherein the advertising information retriever is further configured to process another user search including one of a response to a survey questionnaire transmitted to the user as the advertising information and an order for a selected product.

10. (previously presented): An advertising content interface configured to provide advertising information adapted for transmission over a digital broadcast channel of a television network by a television network headend, said advertising content interface comprising:

an interface unit configured to receive content information from an advertiser via an internet;

a cable content generator configured to process the content information received by said advertiser interface and to generate advertising information adapted for transmission over the cable network; and

a data gateway configured to store the advertising information generated by said cable content generator and to respond to an information demand from the cable network by providing the advertising information to the cable network headend for transmission over the cable network.

11. (original): The advertising content interface of claim 10, wherein the data gateway provides the advertising information to the cable network headend for transmission over the cable network responsive to the information demand, the information demand being a transmission of a user command over the cable network by a user.

12. (original): The advertising content interface of claim 10, wherein the content information includes at least one of a geographic parameter and a temporal parameter, such that the cable network transmits the advertising information corresponding to the content information only within, respectively, a geographical area and a time period.

13. (original): The advertising content interface of claim 10, wherein the advertising information includes at least one of an advertiser listing, a text message, a survey questionnaire, a picture, an audio clip, and a video clip.

14. (original): The advertising content interface of claim 10, further comprising a business mediator, configured to validate an order from the advertiser, the order requesting transmission of the content information to be transmitted.

15. (original): The advertising content interface of claim 10, further comprising a delivery status interface configured to generate a report provided to the advertiser about delivery of the advertising information over the cable network, the report including the number of times the advertising information was viewed.

16. (previously presented): A method of receiving content information and to provide advertising information over a cable network, said method comprising:

receiving content information from an advertiser via an internet;

processing the content information received and generating advertising information adapted for transmission over the cable network;

storing the generated advertising information;

receiving via the digital broadcast channel of the television network an advertising search and retrieving the stored advertising information according to the advertising search; and

providing the retrieved advertising information via the digital broadcast channel of the television network.

17. (original): The method of claim 16, wherein the advertising information includes at least one of an advertiser listing, a text message, a survey questionnaire, a picture, an audio clip, and a video clip.

18. (original): The method of claim 16, wherein the advertising search includes at least one of an advertising information geographic selection and an advertising information temporal selection, selecting, respectively, advertising information designated by the advertiser for a designated geographical area and advertising information designated by the advertiser for a designated time period.

19. (previously presented): The method of claim 16, further comprising processing a user search including at least one of a response to a survey questionnaire transmitted as the advertising information and an order for a selected item based on the advertising information.

20. (previously presented): The television network content delivery system of claim 1, wherein the user search is provided to the television network via a satellite network.

Appeal Brief Under 37 C.F.R. § 41.37
U.S. Application No. 10/523,827

Attorney Docket No.: A8400

EVIDENCE APPENDIX:

None

Appeal Brief Under 37 C.F.R. § 41.37
U.S. Application No. 10/523,827

Attorney Docket No.: A8400

RELATED PROCEEDINGS APPENDIX

None